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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/661,724	09/12/2003	Joel Tenney	43557.264016	8280
826	7590	10/13/2006		
ALSTON & BIRD LLP BANK OF AMERICA PLAZA 101 SOUTH TRYON STREET, SUITE 4000 CHARLOTTE, NC 28280-4000			EXAMINER STITZEL, DAVID PAUL	
			ART UNIT 1616	PAPER NUMBER

DATE MAILED: 10/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No. 10/661,724	Applicant(s) TENNEY ET AL.	
	Examiner David P. Stitzel, Esq.	Art Unit 1616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 September 2006.
- 2a) ☐ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-47 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-47 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

OFFICIAL ACTION

Acknowledgment of Receipt

The new Examiner of record acknowledges receipt of the Applicants' Election, *with traverse*, of Invention I encompassing claims 1-31, which was filed on September 11, 2006, in response to the Restriction Requirement as set forth in the Official Action dated August 11, 2006. Upon reconsideration, the restriction requirement that was made in the aforementioned Official Action is hereby withdrawn in favor of the following restriction requirement, as set forth hereinbelow.

Restriction/Election

Restriction to one of the following inventions is required under 35 U.S.C. § 121:

- I. Claims 1-11 are drawn to a method for attracting arthropods with a volatilized hydrochloric acid produced by combining an ferric chloride hydrate volatile acid precursor with water, as classified in class 424, subclass 666.
- II. Claims 12-21 are drawn to a method for attracting arthropods with carbon dioxide and a volatilized hydrochloric acid produced by combining a carbonate carbon dioxide precursor and an ferric chloride hydrate volatile acid precursor with water, as classified in class 424, subclass 700.
- III. Claims 22-31 are drawn to a method for attracting arthropods with a volatilized hydrochloric acid produced by combining an L-lactic low volatility acid and a sodium chloride volatile acid salt with water, as classified in class 424, subclass 405.
- IV. Claims 32-41 are drawn to a composition comprising an ferric chloride hydrate volatile acid precursor and a carbonate carbon dioxide precursor, as classified in class 423, subclasses 419.1 and 438.

V. Claims 42-47 are drawn to a composition comprising an L-lactic low volatility acid, a sodium chloride volatile acid salt, and water, as classified in class 562, subclass 589.

1. Inventions I/II/III and IV/V are related as a products and methods of using said products, respectively. The inventions can be shown to be distinct if either or both of the following can be shown that: (1) the method of using the product as claimed can be practiced with another materially different product; or (2) the product as claimed can be used by another method that is materially different from the instantly claimed method of using said product. See MPEP § 806.05(h). In the instant case, the products claimed in Inventions I/II/III can be used by another method that is materially different from the methods claimed in Inventions IV/V. For example, as opposed to using said compositions for attracting arthropods as claimed in Inventions IV/V, the compositions claimed in Inventions I/II/III may alternatively be used for sanitizing and disinfecting industrial water.

Inventions I and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that: (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability; and (2) the subcombination has utility by itself or in other combinations. See MPEP § 806.05(c). In the instant case, the combination as claimed in Invention I does not require the particulars of the subcombination as claimed in Invention II because the method and corresponding composition of Invention I does not require the carbonate carbon dioxide precursor of Invention II for patentability. The subcombination of Invention II has separate utility such sanitizing and disinfecting industrial water.

Inventions I and III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects. See MPEP §§ 802.01 and 806.06. In the instant case, the method and corresponding

composition claimed in Invention I has a mode of operation that is dependent upon the physicochemical properties of an ferric chloride hydrate volatile acid precursor, whereas the method and corresponding composition claimed in Invention III has a mode of operation that is dependent upon the physicochemical properties of an L-lactic low volatility acid and a sodium chloride volatile acid salt. As a result, the method and corresponding composition claimed in Invention I has a materially different mode of operation from the method and corresponding composition claimed in Invention III and are therefore unrelated.

Inventions IV and V are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects. See MPEP §§ 802.01 and 806.06. In the instant case, the composition claimed in Invention IV has a mode of operation that is dependent upon the physicochemical properties of an ferric chloride hydrate volatile acid precursor and a carbonate carbon dioxide precursor, whereas the composition claimed in Invention V has a mode of operation that is dependent upon the physicochemical properties of an L-lactic low volatility acid and a sodium chloride volatile acid salt. As a result, the composition claimed in Invention IV has a materially different mode of operation from the composition claimed in Invention V and are therefore unrelated.

Because these inventions are independent and distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, the prior art search required for each respective invention would be divergent, thereby causing an undue search burden. As a result, restriction for examination purposes as indicated is proper. Applicants are therefore required under 35 U.S.C. § 121 to elect a single invention for prosecution on the merits.

2. Claims 1, 3, 4, 7, 12, 14, 22, 24, 25, 27 and 35 are generic to a plurality of disclosed patentably distinct species of volatilized acid (i.e., hydrochloric acid). See [0014] of U.S. Pre-Grant Patent Application Publication 2004/0126402 (hereinafter the Tenney '402 publication), which is the published version of the instant application, for a disclosure of a plurality of patentably distinct species of volatilized acid. Even though this requirement is traversed, in the event that Applicants elect either Invention I, II, III, IV, or V for prosecution on the merits, Applicants are required under 35 U.S.C. § 121 to elect, for search purposes only, a single disclosed patentably distinct species of *volatilized acid (i.e., hydrochloric acid)* for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held allowable. Currently, claims 1, 3, 4, 7, 12, 14, 22, 24, 25, 27 and 35 are generic.

In addition, claims 1, 5, 6, 8, 9, 11, 12, 15, 17-19, 21, 32-36, 38, 40 and 41 are generic to a plurality of disclosed patentably distinct species of volatile acid precursor (i.e., ferric chloride hexahydrate). See [0015] of the Tenney '402 publication for a disclosure of a plurality of patentably distinct species of volatile acid precursor. Even though this requirement is traversed, in the event that Applicants elect either Invention I, II, or IV for prosecution on the merits, Applicants are also required under 35 U.S.C. § 121 to elect, for search purposes only, a single disclosed patentably distinct species of *volatile acid precursor (i.e., ferric chloride hexahydrate)* for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held allowable. Currently, claims 1, 5, 6, 8, 9, 11, 12, 15, 17-19, 21, 32-36, 38, 40 and 41 are generic.

In addition, claims 12, 16, 18, 19, 21, 32, 33, 37, 38, 40, 41 and 46 are generic to a plurality of disclosed patentably distinct species of carbon dioxide precursor (i.e., sodium bicarbonate). See [0018] of the Tenney '402 publication for a disclosure of a plurality of patentably distinct species of carbon dioxide precursor. Even though this requirement is traversed, in the event that Applicants elect

either Invention II, IV, or V for prosecution on the merits, Applicants are also required under 35 U.S.C. § 121 to elect, for search purposes only, a single disclosed patentably distinct species of *carbon dioxide precursor (i.e., sodium bicarbonate)* for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held allowable. Currently, claims 12, 16, 18, 19, 21, 32, 33, 37, 38, 40, 41 and 46 are generic.

In addition, claims 22, 26, 28, 29, 31, 42 and 45 are generic to a plurality of disclosed patentably distinct species of low volatility acid (i.e. L-lactic acid). See [0020] of the Tenney '402 publication for a disclosure of a plurality of patentably distinct species of low volatility acid. Even though this requirement is traversed, in the event that Applicants elect either Invention III or V for prosecution on the merits, Applicants are also required under 35 U.S.C. § 121 to elect, for search purposes only, a single disclosed patentably distinct species of *low volatility acid (i.e. L-lactic acid)* for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held allowable. Currently, claims 22, 26, 28, 29, 31, 42 and 45 are generic.

In addition, claims 22, 27, 28, 29, 31 and 42-44 are generic to a plurality of disclosed patentably distinct species of volatile acid salt (i.e., sodium chloride). See [0020] of the Tenney '402 publication for a disclosure of a plurality of patentably distinct species of volatile acid salt. Even though this requirement is traversed, in the event that Applicants elect either Invention III or V for prosecution on the merits, Applicants are also required under 35 U.S.C. § 121 to elect, for search purposes only, a single disclosed patentably distinct species of *volatile acid salt (i.e., sodium chloride)* for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held allowable. Currently, claims 22, 27, 28, 29, 31 and 42-44 are generic.

Furthermore, claims 6, 17, 29 and 33 are generic to a plurality of disclosed patentably distinct species of a porous carrier (i.e., zeolite). See [0016] of the Tenney '402 publication for a disclosure of

a plurality of patentably distinct species of porous carrier. Even though this requirement is traversed, in the event that Applicants elect either Invention I, II, III, or IV for prosecution on the merits, Applicants are further required under 35 U.S.C. § 121 to elect, for search purposes only, a single disclosed patentably distinct species of *porous carrier (i.e., zeolite)* for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held allowable. Currently, claims 6, 17, 29 and 33 are generic.

The disclosed species are patentably distinct, each from the other, because they possess different molecular structures, as well as different physicochemical properties. Therefore, restriction for examination purposes as indicated is proper. Applicants should also include a listing of all claims, in addition to any claims subsequently added thereto, which are readable upon the species that is elected consonant with this requirement.

Conclusion to Restriction Requirement

The Examiner has required restriction between product and methods of using claims. Where Applicant elects claims directed to a product, and the product claim is subsequently found allowable, withdrawn methods of using claims that depend from or otherwise include all the limitations of the allowable product claim will be rejoined in accordance with the provisions of MPEP § 821.04. Methods of using claims that depend from or otherwise include all the limitations of the patentable product claim will be entered as a matter of right if the amendment is presented prior to final rejection or allowance, whichever is earlier.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined methods of using claims will be withdrawn, and the rejoined methods of using claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. §§ 101, 102, 103

and 112. Until an elected product claim is found allowable, an otherwise proper restriction requirement between product claims and methods of using claims may be maintained. Withdrawn methods of using claims that are not commensurate in scope with an allowed product claim will not be rejoined. See "Guidance on Treatment of Product and Process Claims in light of *In re Ochiai*, *In re Brouwer* and 35 U.S.C. § 103(b)," 1184 O.G. 86 (March 26, 1996). Additionally, in order to retain the right to rejoinder in accordance with the above policy, Applicants are advised that the methods of using claims should be amended during prosecution either to maintain dependency on the product claims or to otherwise include the limitations of the product claims. Failure to do so may result in a loss of the right to rejoinder. Further, note that the prohibition against double patenting rejections of 35 U.S.C. § 121 does not apply where the restriction requirement is withdrawn by the Examiner before the patent issues. See MPEP § 804.01.

Applicants are advised that a fully responsive reply to this requirement must include an explicit identification of a single disclosed patentably distinct species of: 1. volatilized acid (i.e., hydrochloric acid); 2. volatile acid precursor (i.e., ferric chloride hexahydrate); 3. carbon dioxide precursor (i.e., sodium bicarbonate); 4. low volatility acid (i.e. L-lactic acid); 5. volatile acid salt (i.e., sodium chloride); and 6. porous carrier (i.e., zeolite), that is elected consonant with this requirement, and a listing of all claims, including any claims subsequently added thereto, which are readable upon the elected species. An argument that a claim is allowable or that claims are not generic is considered nonresponsive unless accompanied by an explicit election of a specific species. See 37 C.F.R. § 1.143.

Should Applicants traverse on the ground that the species are not patentably distinct, Applicants should submit evidence or identify such evidence now of record showing the species and subspecies to be obvious variants over one another or clearly admit on the record that this is the case.

In either instance, if the Examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. § 103(a) of the other inventions.

If claims are added after the election, Applicants must explicitly indicate which claims are readable upon the elected species. See MPEP § 809.02(a). Amendments submitted after final rejection are governed by 37 CFR 1.116, whereas amendments submitted after allowance are governed by 37 CFR 1.312.

Applicants are reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR § 1.48(b) if one or more of the currently named Inventors is no longer an actual Inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR § 1.48(b) and by the fee required under 37 CFR § 1.17(i).

Due to the complex nature of the instant restriction requirement, a written restriction requirement was necessitated. See MPEP § 812.01.

Contact Information

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to David P. Stitzel, M.S., Esq., whose telephone number is 571-272-8508. The Examiner can normally be reached on Monday-Friday, from 7:30AM-6:00PM.

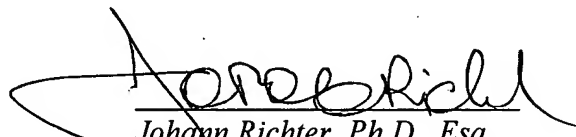
If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Mr. Johann Richter, Ph.D., Esq., can be reached at 571-272-0646. The central fax number for the USPTO is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published patent applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished patent applications is only available through Private PAIR. For more information about the PAIR system, please see <http://pair-direct.uspto.gov>. Should you have questions about acquiring access to the Private PAIR system, please contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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